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In re Application of
Bunichi Shoji
Application No. 09/245,720
Filed: February 8, 1999
For: A Truss Structure, Structural Members Thereof,
And a Method of Manufacture Thereof

:
: **DECISION ON PETITION**
: **UNDER 37 CFR §1.181**
:

This is a decision on applicant's Petition To Withdraw Notice of Abandonment, filed on January 24, 2006.

The petition is **GRANTED**.

Petitioner asserts that the abandonment of the instant application through failure to properly meet the drawing requirements noted in the Ex parte Quayle action mailed October 18, 2004 was improper.

A review of the file shows that an Office action mailed October 18, 2004 indicated that all pending claims were allowed but the drawings were objected to. The prosecution history shows that applicant made several attempts to comply with the drawing correction request but none were acceptable and the application was ultimately held abandoned.

Applicant indicates that a divisional application issued as a patent (6,604,401) without any noted drawing problems. It should be noted that this patent issued with claims to a die and method whereas the instant application has claims drawn to a truss structure. Therefore, the relevant drawings needed to understand the truss structure would not be the drawings showing the die structure.

Applicant argues that the Office has not shown where the missing subject matter is actually claimed subject matter. The claims are drawn to a truss structure with upper, lower and diagonal chord members. The claims further define the joint structure between these elements. The drawing objection as set forth in the Office action of October 18, 2004 specifically stated that figures 1 and 2 show a schematic of the truss structure, in other words they show the basic upper, lower and diagonal truss members and figures 3 and 6-8 show details of the joints. Therefore it is rather clear that the missing interconnection details are claimed subject matter.

Applicant argues that the structure is of a simple nature and one of ordinary skill in the art can understand the invention. Figures 1 and 2 show the basic truss layout, perhaps better seen in figure 2 where there are upper chord members (2), lower chord members (1) and diagonals (3). Cross plates (4) are also shown and it is assumed these are some sort of junction plate. This configuration is old and easily understood. Figures 3 and 6-8 apparently show applicant's joint structure in detail. Herein lies the problem. There is no way to relate the joint structure shown in figures 3 and 6-8 to the general truss structure. The specification indicates (10) is a connection part of the chord member. Elements 15 and 16 are listed as "parent plates" but it is not known where these plates are oriented in terms of cross plate (4) or any of the upper, lower or diagonal chords. One of ordinary skill in the art is left with a truss schematic, details of a specific joint of "a chord" to "parent plates" and no indication of how this has anything to do with diagonal chords meeting upper or lower chords. The original examiner could not ascertain this when she first raised this point and a second examiner who was subsequently assigned to the application and his supervisor could not ascertain this when the drawing objection was again raised. The allowable subject matter did not deal directly with the missing relationship which is why the claims were indicated as allowable.

However, a review of the responses from applicant reveals that applicant made a good faith effort to comply with the drawing requirements of the examiner as they were set forth in the various office actions. In the Office action mailed October 18, 2004, the examiner objected to the drawings because there were no drawing figures that tied the details of figures 3 and 6-8 to the schematic and that there were no common reference numbers between the two sets of drawings. In the response filed December 20, 2004, applicant proposed to amend the drawings to provide common reference numbers in 3,4,6 and 8. Thus it would appear that applicant satisfied the examiner's requirement. However, the examiner made new complaints in the Notice of Non-Compliant Amendment mailed July 5, 2005 wherein the drawings were held as not properly identified as "Replacement Sheet" and the "circles" markup on figure 8(a,b) were questioned. Applicant responded to this Notice on July 28, 2005 wherein the

"Replacement Sheet" identifier was supplied and an explanation of the circles were offered. Thus, it would again appear that applicant fully responded to the examiner's requirements. However, an Office letter was mailed October 17, 2005 wherein the examiner repeated the original complaint that there were no drawing figure which ties the details of figures 1-2 with the details of figures 3 and 6-8. The period for response was not reset and continued to run from the Notice mailed July 5, 2005. Applicant responded again on November 2, 2005 and attempted to explain the circles complained of. The examiner held the application abandoned in the Notice of Abandonment mailed January 13, 2006 wherein it was maintained that the detailed relations of figures 1,2 with figures 3 and 6-8 were still not provided.

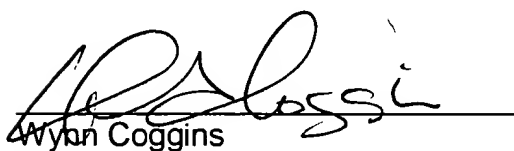
Based on the chronology discussed above, it appears that applicant responded to the examiner's objections as best he could. If the response was inadequate, the examiner should have explained in detail why the response did not overcome the objection rather than merely repeating the objection. The holding of abandonment is therefore withdrawn.

The petition to withdraw abandonment is **GRANTED**.

If the examiner is of the opinion that drawing objections should be maintained, he should explain the objection in detail and explain why the responses from applicant do not overcome the objections.

Alternatively, if the examiner's concern over a lack of proper disclosure is one that should be addressed under 35 USC 112 rather than drawing objections, then such a rejection should be made.

The application is being returned to the examiner for further action on the merits.



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